

Appl. No. : 09/921,061
Filed : August 1, 2001

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following remarks. Claims 1-11 and 14-36 remain pending for examination.

Discussion of Declarations of Dr. Tim Becker and Karl Meimer

Applicant has provided herewith a statement of Dr. Tim Becker and Karl Meimer regarding certain activity relating to the development and testing of software. Applicant respectfully submits that due to the nature and limited duration of these activities, that they do not constitute prior art under 35 U.S.C. § 102(b).

The statement of Dr. Tim Becker describes the usage of a prototype of the Marketing Masterfully program that was used in his class for testing purposes. Dr. Becker used the results of the program to monitor the success of learning of the students. Courts often consult evidence of monitoring to discern the distinction between experimental and commercial sales. *See EZ Dock, Inc. v. Schafer Systems, Inc.* Furthermore, Applicant notes that the version of the Marketing Masterfully that was used in the testing did not include all of the claimed features, e.g., question randomization. "When an inventor can show changes during experimentation that result in features later claimed in the patent application, this evidence is a strong indication that the activities of the inventor negated any evidence of premature commercial exploitation of an invention ready for patenting." *See EZ Dock Inc. v. Schafer Systems, Inc.* Moreover, Applicant notes that the students in the class were only able to use the software for a limited duration due to a software time bomb that deactivated the software after a certain time period. Furthermore, Applicant respectfully submits that Dr. Karl Meimer's limited disclosure did not constitute a "public use" of the invention under 35 U.S.C. § 102(b).

Discussion of Rejections Under 35 U.S.C. § 112

The Examiner has rejected Claims 14 and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

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applicant regards as the invention. The Examiner noted that these claims are dependent on a rejected claim. Applicant has corrected this by the above-amendments.

Discussion of Rejections Under 35 U.S.C. § 102

In the Office Action, Claims 3-17, 20-30, and 32-36 were rejected under 35 U.S.C. § 102(e) as being anticipated by Vaughan, Jr. (U.S. Pat. No. 6,419,496).

Applicant respectfully disagrees. However, as Applicant has filed with this response a Declaration by Erwin Karl Meimer under 37 C.F.R. § 1.131 that Applicant believes removes the Vaughan reference from consideration, Applicant has not presented arguments in support of the patentability of these claims. In the Declaration, Mr. Meimer, the sole inventor, states that the invention claimed in the present application was reduced to practice prior to March 28, 2000. Applicant has included with the Declaration Exhibits A, B, C, D, E and F, which show actual reduction to practice prior to March 28, 2000. Consequently, Applicant respectfully submits that the Vaughan patent is not available as a prior art reference under 35 U.S.C. § 102(e).

In the Office Action and during a telephonic interview, the Examiner indicated that she would like further evidence supporting a reduction to practice of the invention. Applicant respectfully submits that he was provided supplemental evidence of reduction to practice as requested by the Examiner. In particular, the Applicant has provided a true reproduction of the Marketing Masterfully program that was provided to Point Loma Nazarene University. The reproduction is based from archive files and documents that defined the original packaging. Applicant notes that the program is installable by the Examiner if desired. Furthermore, Applicant has provided a true reproduction of a marketing brochure that was created at least by March 28, 2000 for promotion and marketing of the software.

Applicant respectfully submits that the rejections of Claims 3-17, 20-30, and 32-36 under 35 U.S.C. § 102(e) are thus overcome. Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 102(e) rejections and allowance of Claims 3-17, 20-30, and 32-36.

Discussion of Rejections Under 35 U.S.C. § 103

In the Office Action, Claims 1, 2, 18, 19 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vaughan, Jr. (U.S. Pat. No. 6,419,496) in view of Ho et al. (U.S. Pat.

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No. 6,212,358). Applicant respectfully submits that these claims are patentable over the cited references, as discussed below.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

As discussed above with regard to the 35 U.S.C. § 102 rejections, the Vaughan reference is also not available as a prior art reference under 35 U.S.C. § 103(a) due to the 37 C.F.R. § 1.131 petition. Applicant respectfully submits that a *prima facie* case of obviousness has not been established regarding Claims 1, 2, 18, 19 and 31 based solely on the Ho et al. reference. For example, the Examiner has not made the necessary showing that the Ho et al. reference alone teaches or suggests all the limitations of these claims.

In view of the foregoing, Applicant respectfully submits that the rejections of Claims 1, 2, 18, 19 and 31 under 35 U.S.C. § 103(a) are thus overcome. Accordingly, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejections and allowance of Claims 1, 2, 18, 19 and 31.

CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the April 10, 2003 Office Action. Accordingly, amendments to the claims, the reasons therefore, a petition under 37 C.F.R. § 1.131, and arguments in support of the patentability of the pending claim set are presented. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the capacity of the claims to particularly and distinctly point out the invention to those of skill in the art.

In light of the above amendments, petition and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

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Respectfully submitted,

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